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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,945	07/10/2000	Tomoo Tsunenari	37B.P61	9915
5514	7590	12/09/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,945

Applicant(s)

TSUNENARI, TOMOO

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 . 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant filed a Request for Continued Examination under 37 CFR 1.114 and requested consideration of previously amendment/reply und 37 CFR 1.116 previously filed 21 July 2003. The Applicant amended Claims 1, 10, 15, 16, and 23. All pending claims, 1-27, were examined in this non-final Office Action.

Response to Arguments

Applicant's arguments, see Remarks, pages 10-14, filed 21 July 2003, with respect to the rejection(s)of claim(s) 1-27 under 35 USC 102(e) and 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of USPS and SmartShip. USPS and SmartShip provide the basis for the rejection teaching online merchandise return, recyclable toner cartridges as returnable product, customers printing shipping labels on laser printers and affixing labels for return package shipping, and return destination based on the product type.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: see at least Figure 2, S200; Figure 5, 51; Figure 7, 71. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. **Claims 1 and 7-9 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims lack structural specificity. The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or

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mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 5-6, 10, 13, 15-16, 22-23, and 26 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-X) in view of SmartShip (a collection of articles cited in PTO-892, Items: UU-VV).**

USPS teaches Returns@ease software program (please note the software program contains code for the computer to execute) allowing customers to notify a participating web merchant about the item they wish to return, printing out on the customer's printer in seconds a pre-paid merchandise return label from the company's retail web site, and returning the item via pickup or drop-off at a

mailbox of post office (Item: U, please see page 1). USPS teaches recyclable toner cartridges as returnable items, the practice of high-end retailers including shipping labels with products and using United Parcel Service's authorized return service and e-shipping that allows online customers to pay by credit card, generate a label, and drop the package off at a UPS counter (Item: U, see page 2). USPS teaches a) Altrec.com implementing USPS' electronic merchandise return service, also known as Returns@ease, which allows the company to credit customers faster than traditional cataloguers or brick-and-mortar companies that include return labels with every shipment, b) when Altrec.com's electronic return label is created the company's warehouse and customer service people are immediately alerted and have all the information about the item being returned, reason, and price (Item: U, see page 2), and c) Altrec.com testing the online program with USPS in the middle of September 1999, scanning returned merchandise label and automatically crediting the customer's credit card (Item: V, see page 1). USPS teaches Return@ease receiving return shipping data from a merchant's web site, customers printing out the label, which is actually a two-dimensional indicia or bar code containing shipping information, on any printer (Item: W, page 1), and expanding the returns service to reroute the package to an online auctioneer, who would sell the item and then send the proceeds to the retailer (Item: X, page 1).

USPS teaches all the above as noted under the 103(a) rejection and teaches a) USPS' electronic merchandise return service (Returns@ease) automatically

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determining the carrier service and transmitting a merchant's address (destination for the returned product) information to be printed by the customer to be affix to the returned merchandise's packaging, and b) routing a returned merchandise package to a third-party destination (e.g. auctioneer) based on type of product (e.g. product is not selling well) (Item: X, page 3), but does not disclose automatically determining a present location of the merchandise. SmartShip teaches SmartShip.com receiving approval to provide electronic retailers access to the USPS electronic merchandise returns services (Item: UU, see page 1), and further teaches use of customer zip code and shipping destination zip code to compare shipping rates and to select among a finite list of competing carriers displayed to the user (Item: UU, page1, Item: VV, page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify USPS to include zip code information to determine present location of the merchandise as taught by SmartShip, in order to determine a cost effective carrier service.

- 4. Claims 2-3, 17-18, and 24-25 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-X) and SmartShip (a collection of articles cited in PTO-892, Items: UU-VV), as applied to Claims 1, 16, and 23, further in view of Caldwell (PTO-892, Item: UUU).**

USPS and SmartShip teach all the above as noted under the 103(a) rejection and teach merchandise return processing via a web site, and transmitting purchase information during the approval process but do not disclose product serial numbers and customer information stored in a database. Caldwell teaches reverse logistics as the handling and disposition of returned goods, being crucial for online sales due to staggering amount of returned products, and WorldSpy integrating online reverse logistics into its shopping portals. Caldwell teach customers filling out a return notice on WorldSpy's web site, customers being advised to send the item(s) to a central warehouse managed by UPS Worldwide Logistics or directly back to the manufacturer, and teach building the system using Visual Basic and Microsoft's SQL Server 7.0 database. Caldwell further teaches Great Plains Software concentrating on reverse logistics, and implementing a returns management module that uses serial numbers to track returned parts throughout the process (Item: UUU, see at least pages 2-3, and 6). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system, method, and program code of USPS and SmartShip to include use of product serial numbers in a reverse logistics process and web sever database to manage information as taught by Caldwell, in order to efficiently track and manage the online returns process.

- 5. Claims 4, 11-12, and 27 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-**

X), SmartShip (a collection of articles cited in PTO-892, Items: UU-VV), and Caldwell (PTO-892, Item: UUU), as applied to Claims 2, 10, and 23, further in view of Lidsky (PTO-892, Item: VVV) and Williams et al. (patent application publication number 2002/0032573).

USPS, SmartShip, and Caldwell teach all the above as noted under the 103(a) rejection but do not disclose using name and password identification. Lidsky teaches SmartShip.com competing with iShip.com in the same market to provide customers with an easy way to pick a carrier service. Williams et al. teach the system and method of iShip.com of providing online merchandise return services, storing information in databases, and further teach use of name and password protection by authorized customers and customer printing shipping label for selected package carrier (see at least abstract; Fig. 7; Fig. 30a (22, 4362); Figs. 30b-c; Fig. 31 (4402); Fig. 32 (4420); Fig. 34 (22, 752, 815); Fig. 36 (900, 907, 908); Fig. 52 (330); col. 14, paragraph 0262 through col. 16, paragraph 0281). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system, method, and program code of USPS, SmartShip, and Caldwell to include customer identification information as taught by Lidsky and Williams et al., in order to attract users wanting to use a secure commerce site for shipping return

- 6. Claims 7, 9, and 19-20 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-**

X) and SmartShip (a collection of articles cited in PTO-892, Items: UU-VV), as applied to Claims 1 and 16, further in view of PR Newswire (PTO-892, Item: WW).

USPS and SmartShip teach all the above as noted under the 103(a) rejection and teach a recyclable toner cartridge as a returnable product and the customer printing the return shipping label on any type of printer and specifically on a laser printer (Items: U, page 2; W, page 1; UU, page 1), but do not specifically disclose a laser printer toner cartridge as a returnable recyclable product. PR Newswire teaches Canon USA introducing new laser printers into the market place, the use of laser toner cartridges, Canon USA instituting the Clean Earth Campaign in 1990 which supports environmental issues, and collecting millions of toner cartridges for recycling and reuse. Therefore it would have been obvious to one of ordinary skill in the art to modify the system and method of USPS and SmartShip to disclose laser printer toner cartridges as returnable product for recycling as taught by PR Newswire, in order to attract customers desiring to return recyclable laser toner cartridges.

- 7. Claims 8 and 21 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-X), SmartShip (a collection of articles cited in PTO-892, Items: UU-VV), and PR Newswire (PTO-892, Item: WW), as applied to Claims 1 and 20, further in view of Martin (PTO-892, Item: XX)**

USPS, Smartship, and PR Newswire teach all the above as noted under the 103(a) rejection and teach Canon recycling printer cartridges, but do not disclose the use of a chip adapted to a printer cartridge to collect product information. Martin teaches laser printer toner cartridge recycling, Canon competitors producing Canon compatible cartridges, and introduction of smart supplies used in laser printers, and by example the Lexmark LaserJet 8100 cartridge having chips that provide feedback to users on toner usage and other information. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of USPS, SmartShip, and PR Newswire to include a chip adapted to a product as taught by Martin, in order to facilitate efficient product use.

- 8. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in PTO-892, Items: U-X) and SmartShip (a collection of articles cited in PTO-892, Items: UU-VV), as applied to Claim 10, in view of Gralla (Paper #4, PTO-892, page 2, Item: V).**

USPS and SmartShip teach all the above as noted under the 103(a) rejection further teach transmitting information via a web interface, but do not disclose the use of a cookie to pass or collect information from the customer's computer. Gralla teaches the use of cookies by Internet web sites to pass and collect information from a web client computer. Gralla teaches cookies as bits of data being deposited on a client's hard disk when visiting the web site, and the cookie

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being used to convey information to the server. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of USPS and SmartShip to use the customer's cookie as taught by Gralla, in order to make it easier to conduct electronic business with the web server.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

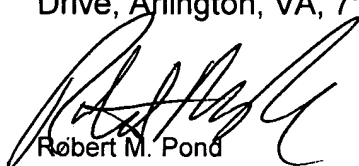
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or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
December 1, 2003